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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,059	09/25/2003	Kyle N. Patrick	CA920020057US1	5839
7590 David A. Mims, Jr. International Business Machines, Intellectual Property Law 11400 Burnet Road Austin, TX 78758			EXAMINER KEEFER, MICHAEL E	
			ART UNIT 2112	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/16/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/671,059

Applicant(s)

PATRICK, KYLE N.

Examiner

Michael E. Keefer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

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DETAILED ACTION

1. The following office action is in response to the Application filed 9/25/2003.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

3. Claims 1, 3-5, 9-10, 11, 13, 15-16, 19-20, 21, 23, and 25 are objected to because of the following informalities:

Regarding **claim 1**, the word "the" between "in" and "memory" should be deleted in line 3, the word "the" should also be deleted between the words "parsing" and "contents" and between "of" and "said" to improve the clarity of the claim.

In line 7, the word "said" between "by" and "user" should be deleted and replaced with the word --a-- to improve the clarity of the claim.

Regarding **claim 3**, the word "a" in line 2 between "by" and "user" should be deleted and replaced with the word --said-- to improve the clarity of the claim.

Regarding **claim 4**, the word "a" in line 1 between "initiating" and "reply" should be deleted and replaced with the word --said-- to improve the clarity of the claim.

Regarding **claim 5**, the word "said" in line 2 should be deleted and replaced with --a-- to improve the clarity of the claim.

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Regarding **claim 9**, the word “response” in line 1 should be deleted and replaced with --reply-- to improve the clarity of the claim.

The word “addresses” in line 2 should be deleted and replaced with the word --addresses.-- to improve the clarity of the claim.

Regarding **claim 10**, the word “response” in line 1 should be deleted and replaced with --reply-- to improve the clarity of the claim.

Regarding **claim 11**, in line 5 the word “for:” should be deleted and replaced with the word --for:-- to improve the clarity of the claim.

The word “the” in line 6 between “parsing” and “contents” should be deleted as well as the word “the” in line 6 between “of” and “said”.

The word “the” in line 7 should be deleted to improve the clarity of the claim.

The word “said” in line 10 between “by” and “user” should be deleted and replaced with the word --a-- to improve the clarity of the claim.

Regarding **claim 13**, the word “a” in line 2 should be deleted and replaced with the word --said-- to improve the clarity of the claim.

Regarding **claim 14**, the word “a” in line 1 should be deleted and replaced with the word --said-- to improve the clarity of the claim.

Regarding **claim 15**, the word “said” in line two should be deleted and replaced with the word --a-- to improve the clarity of the claim.

Regarding **claim 16**, the word “message” at the end of line 2 should be deleted and replaced with the word --message.-- to improve the clarity of the claim.

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Regarding **claim 19**, the word “response” in line 1 should be deleted and replaced with --reply-- to improve the clarity of the claim.

Regarding **claim 20**, the word “response” in line 1 should be deleted and replaced with --reply-- to improve the clarity of the claim.

Regarding **claim 21**, the word “the” in line 5 should be deleted to improve the clarity of the claim.

The word “the” in line 6 between “parsing” and “contents” should be deleted as well as the word “the” in line 6 between “of” and “said” to improve the clarity of the claim.

The word “said” in line 9 between “by” and “user” should be deleted and replaced with the word --a-- to improve the clarity of the claim.

Regarding **claim 23**, the word “a” in line 2 should be deleted and replaced with the word --said-- to improve the clarity of the claim.

Regarding **claim 25**, the word “said” in line two should be deleted and replaced with --a-- to improve the clarity of the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 6, 11, 16, 21, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding **claims 1, 11, and 21**, the word “recipients” in the last line of the claim is confusing because line 1 of the claim also recites “recipients” and it is unclear whether the recipients recited in both places are actually the same or not.

Regarding **claims 6, 16, and 26**, the phrase “said message” in line 2 of the claim is confusing because it is unclear to what previously recited message is being referred to; the “received email message” or the “reply email message”.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding **claim 1**, which is directed to a method of selecting recipients of an email message. As stated in applicant's disclosure on page 5 in paragraph 2, the invention may be embodied as computer software code, which is merely functional descriptive material and therefore is non-statutory, as functional descriptive material does not fall under one of the four statutory categories of invention.

Claims 2-10 fail to add any statutory subject matter to the claim, and so are rejected for the same.

Regarding **claim 11**, which is drawn to “a computer program product”. In order for a claim to be statutory it must be drawn to a process, article of manufacture, composition of matter, or machine. In accordance with Applicant's

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specification "a computer usable medium" may include "a computer readable modulated carrier signal". (Page 5, paragraph 2) This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claims 12-20 do not remove any non-statutory matter from the claim, therefore are rejected for the same.

Regarding claim 21, which is drawn to an article comprising a modulated carrier signal. Applicant's specification on page 5 in paragraph 2 states, "The invention may also be embodied on a computer readable modulated carrier signal." This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a

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manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claims 22-30 do not remove the non-statutory subject matter from the claim and therefore are rejected for the same.

In addition, **claim 21** is directed merely to functional descriptive material as stated in applicant's specification on page 5 in paragraph 2, "[The present invention] may also be embodied as ... computer software code ..." This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes functional descriptive material. Functional descriptive material does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claims 22-30 do not remove the non-statutory subject matter from the claim and therefore are rejected for the same.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

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application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 9, 11, and 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, and 6 of U.S. Patent No. 6,823,368. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Regarding claim 1 of the instant application which recites:

A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail message comprising:

i) storing said received e-mail message in the memory of said recipient computer; (This step is inherent in claim 1 of '368, as in order to manipulate and read the message it must be stored in some memory.)

ii) parsing the contents of the said received email for e-mail addresses and forming a list of said parsed e-mail addresses; (Claim 1 of '368 recites "searching said body section of said electronic mail message for said chain sender addresses of senders having send said message")

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iii) displaying said list of parsed e-mail addresses; (it would have been obvious to one of ordinary skill in the art at the time of the invention to omit the step of displaying the list of parsed email addresses in order to streamline the program flow) and

iv) forming a reply e-mail message to recipients selected from said list by said user. (Claim 1 of '368 recites: adding a Sender-chain field to an e-mail message header section when forwarding the chain forwarded email message to another recipient.)

Regarding claim 9 of the instant application, which is dependent on claim 1 as shown above, adds the limitation the reply message is formed by auto-populating SMTP headers with the list of email addresses. This step is clearly recited in claim 3 of '368, which is dependent on claim 1 of '368 used above (adding a sender-chain field to a SMTP message).

Claims 11 and 19 of the instant application are identical to claims 1 and 9 of the instant application except for the recitation of a computer program product and computer readable media. Claims 4 and 6 of '368 recite the same limitations of claims 1 and 3 of '368 except for claiming computer-readable media; therefore claims 11 and 19 are rejected for the same reasons as cited above for claims 1 and 9.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hara (US 5938725).

Regarding **claim 1**, Hara discloses:

A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail message comprising:

i) storing said received e-mail message in the memory of said recipient computer; (storage means for storing therein a received electronic mail Col 2. lines 58-59)

ii) parsing the contents of the said received email for e-mail addresses and forming a list of said parsed e-mail addresses; (extracting means for extracting a mail address contained in the electronic mail Col. 2 lines 64-65)

iii) displaying said list of parsed e-mail addresses; (Col 4 Lines 2-8, "outputted as the transmission destination candidates") and

iv) forming a reply e-mail message to recipients selected from said list by said user. (Col 4 lines 8-11 "the user can readily transmit the electronic mail by merely selecting his desired transmission destination from these outputted transmission destination candidates.")

Regarding **claim 3 and as applied to claim 1** Hara discloses:

wherein said list of parsed e-mail addresses is displayed in response to an action by a user. (Col 3, lines 4-9, the process of extraction is started by the user inputting a keyword from an input device.)

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11. Claims 1-3, 5-6, 11-13, 15-16, 21-23, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Birrell et al. (US 6189026 B1) hereafter Birrell.

Regarding **claims 1, 11, and 21**, Birrell discloses:

A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail message comprising:

- i) storing said received e-mail message in the memory of said recipient computer; ("Mail messages are stored in message files of the mail service system" Abstract)
- ii) parsing the contents of the said received email for e-mail addresses and forming a list of said parsed e-mail addresses; (Col 12, lines 16-18 "the system heuristically locates text strings which have the syntax of email addresses")
- iii) displaying said list of parsed e-mail addresses; (Col 12 lines 18-19 "if the user clicks on one of these addresses, inherently the list of addresses must be displayed in order for a user to click on them) and
- iv) forming a reply e-mail message to recipients selected from said list by said user. (Col 12 lines 18-21 "If a user clicks on one of these addresses then the system will display a composition window so that the user can easily generate a reply message to the selected email address(es).)

Birrell discloses that his method can be computer implemented, therefore must be able to be implemented on a computer readable media as recited in claim 11 or a computer readable carrier wave as recited by claim 21.

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Regarding **claims 2, 12, and 22 and as applied to claims 1, 11, and 21,**

Birrell discloses:

wherein said received e-mail message is a multi-party e-mail. (The reply to all function described in Col 14 lines 36-38 clearly shows that emails with multiple parties are included by the disclosed email system.)

Regarding **claims 3, 13, and 23 and as applied to claims 1, 11, and 21,**

Birrell discloses:

wherein said list of parsed e-mail addresses is displayed in response to an action by a user. (Col 12, lines 16-17 disclose that "When displaying retrieved messages" and choosing to display a message is a user action.)

Regarding **claim 5, 15, and 25 and as applied to claims 1, 11, and 21,**

Birrell discloses:

wherein said recipient computer parses said received e-mail message automatically prior to said user action. (Col. 7 lines 23-24 state that messages are processed in batches as they are received.)

Regarding **claim 6, 16, and 26 and as applied to claims 1, 11, and 21,**

Birrell discloses:

wherein said recipient computer parses said received e-mail message automatically upon receipt of said message. (Col. 7 lines 23-24 state that messages are processed in batches as they are received.)

12. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-4, 7-10, 11-14, 17-20, 21-24, 27-30 are rejected under 35 U.S.C.

102(e) as being anticipated by Ullmann et al. (US 7103634 B1) hereafter

Ullmann.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding **claims 1, 11, and 21**, Ullmann discloses:

A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail message comprising:

- i) storing said received e-mail message in the memory of said recipient computer; (this step is inherent as the message must be stored in memory of the computer)
- ii) parsing the contents of the said received email for e-mail addresses and forming a list of said parsed e-mail addresses; (Col 8 lines 55-57 "scanning the attached or inline header fields of the original message")

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iii) displaying said list of parsed e-mail addresses; (the "special field" disclosed in line 54 would display the results of the scanning above) and

iv) forming a reply e-mail message to recipients selected from said list by said user. (Figure 4 step 47 of fully incorporated application 09/672,181 shows that the built list of previous senders and recipients can be used to provide automatic addressing for a reply or forwarded message.)

Ullmann discloses that his method can be computer implemented, therefore must be able to be implemented on a computer readable media as recited in claim 11 or a computer readable carrier wave as recited by claim 21.

Regarding **claims 2, 12, and 22 and as applied to claims 1, 11, and 21**, Ullmann discloses:

wherein said received e-mail message is a multi-party e-mail. (Ullmann specifically discloses that chain messages (i.e. multi-party emails) are processed using his method, "An enhanced e-mail reader and composer having automatic addressing functions to create and manage chain groups for organizing chain-forwarded and chain-replied messages" abstract.)

Regarding **claims 3, 13, and 23 and as applied to claims 1, 11, and 21**, Ullmann discloses:

wherein said list of parsed e-mail addresses is displayed in response to an action by a user. (Fig. 4 of fully incorporated application 09/672,181 where the step of opening and displaying an email is directly followed by the scanning of the email, therefore the act of the user opening the email causes the scanning.)

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Regarding **claims 4, 14, and 24 and as applied to claims 1, 3, 11, 13, 21, and 23**, Ullmann discloses:

wherein said user action comprises initiating a reply message. (Col 10, lines 21-42, where it is described that after a reply message is started a list of possible recipients, "one or more found previous recipients and originators" in lines 34-35)

Regarding **claims 7, 17, and 27 and as applied to claims 1, 11, and 21**, Ullmann discloses:

wherein said recipient computer loads and displays said received email for viewing by said user prior to said parsing step. (In fully incorporated application 09/672181, Col. 6 lines 14-16 states that first the message is opened and displayed, then it is scanned.)

Regarding **claims 8, 18, and 28 and as applied to claims 1, 11, and 21**, Ullmann discloses:

wherein prior to said parsing step said user requests a list of potential reply e-mail addresses. (Col 10, when the user asks to make a reply message, the message is parsed in order to find possible reply candidates as inherently part of forming a reply requires a user to specify to whom the message is going to.

Regarding **claims 9, 19, and 29 and as applied to claims 1, 11, and 21**, Ullmann discloses:

wherein said response message is formed by auto-populating SMTP headers with said list of e-mail addresses (Col. 9 lines 18-22 disclose populating

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the reply-to field of the email automatically with the addresses found in the search of the email.)

Regarding **claims 10, 20, and 30 and as applied to claims 1, 11, and 21**, Ullmann discloses:

wherein said response message is formed by auto-populating user interface graphical elements. (Col 10 lines 29-36 describes that the user is prompted to create an address book entry for a group, in which the group is automatically filled with addresses found in the search of the email.)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Keefer whose telephone number is (571) 270-1591. The examiner can normally be reached on Monday-Thursday 8am-5pm, second Fridays 8am-4pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Jules can be reached on (571) 270-1808. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MEK 1/3/2007

FRANTZ JULES
SUPERVISORY PATENT EXAMINER

A handwritten signature in dark ink, appearing to read 'Frantz', with a large, sweeping flourish extending to the right.